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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/742,033	12/20/2000	Ji Sun	100390-09922	9605

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Barry Evans, Esq.  
Kramer Levin Naftalis & Frankel LLP  
919 Third Avenue  
New York, NY 10022

EXAMINER

TIZIO, STEVEN C

ART UNIT PAPER NUMBER

1627

DATE MAILED: 01/10/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/742,033

Applicant(s)

SUN ET AL.

Examiner

Steven C Tizio

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-12 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

**Please note:** *In an effort to enhance communication with our customers and reduce processing time, Group 1627 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is (703) 305-3704. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this pilot program. If you have any questions or suggestions please contact Jyothnsa Venkat, Ph.D., Supervisory Examiner, at Jyothsna.Venkat@uspto.gov or 703-308-2439. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.*

## Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-2, drawn to the method of generating an electrochemiluminescent emission, classified in class 422, subclass 52.
  - II. Claims 3-4, drawn to the compound which comprises an electrochemiluminescent label linked to a coreactant, classified in class 435, subclass 4.
  - III. Claims 5-6, drawn to the system for generating an electrochemiluminescent emission, classified in class 422, subclass 52.

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- IV. Claims 7-8, drawn to the kit for performing an electrochemiluminescent assay, classified in class 435, subclass 4 and subclass DIG 43.
- V. Claims 9-12, drawn the compound comprising an electrochemiluminescent label linked to a coreactant, classified in class 424, subclass 9.6.

2. The inventions are distinct, each from the other, because of the following reasons:

3. **Groups I-V** represent separate and distinct inventions. **Groups I-V** are drawn to different methods or processes (i.e., e.g., which are directed to different purposes, use different materials, recite different method or process steps for the preparation of different product(s), screening of different characteristics, such as different binding affinities, different biochemical reaction conditions, etc. or lead to different final results). **Group I** is a method, **Groups II, IV, and V** are products, and **Group III** is an apparatus. Therefore, **Groups I-V** have different issues regarding patentability and enablement and represent patentably distinct subject matter, which merits separate and burdensome searches. Art anticipating or rendering obvious each of the above-identified groups respectively would not necessarily anticipate or render obvious another group, because they are drawn to different inventions that have different distinguishing features and/or characteristics.

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4. Inventions of **Group I** (method of generating an electrochemiluminescent emission) and **Group III** (system for generating an electrochemiluminescent emission) are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case there are other systems that can be used to generate an electrochemiluminescent emission, which utilize a variety of electrochemiluminescent labels, a variety of electrochemical energy sources, and a variety of detection systems for measuring emitted luminescence. In addition, the method of Group I can be satisfied with compounds containing a variety of metals and biological compounds, including green fluorescent protein (GFP).

5. Inventions of **Groups II** (compound which comprises an electrochemiluminescent label linked to a coreactant) and **V** (compound comprising an electrochemiluminescent label linked to a coreactant) and **Group I** (method of generating an electrochemiluminescent emission) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case there are other products used for generating an electrochemiluminescent emission, such as using non-

chelating organic compounds and fluorescing proteins that have varying ranges of electrochemical emission and absorption. In addition, there are other methods that can be used to generate electrochemiluminescent emission that do not require a coordinate complex of metal, yet utilize a conjugated organic molecule.

6. Inventions of **Group II** (compound which comprises and electrochemiluminescent label linked to a coreactant) and **Group V** (compound comprising an electrochemiluminescent label linked to a coreactant) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are two different types of compounds, in which the compound described in **Group II** can relate to many different types of compounds and the compound described in **Group V** is specific (contains a particular metal center, chelating groups, and linker groups).

7. These inventions are distinct for the reasons above and have acquired a separate status in the art because of their recognized divergent subject matter and/or shown by their different classifications. While some of the aforementioned groups are classified under an identical class/sub-class, the corresponding non-patent literature search remains unaffected. Each of the identified groups may require different searches. For example, methods and products groups require different searches. Therefore, restriction for examination purposes as indicated is proper.

### Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Tizio whose telephone number is (703) 305-1903. The examiner can normally be reached on Monday through Friday from 8:30 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jyothsna Venkat, can be reached at (703) 308-2439. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

  
**PADMASHRI PONNALURI**  
**PRIMARY EXAMINER**

Steven C. Tizio  
Patent Examiner  
AU 1627